

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

### **REMARKS/ARGUMENTS**

#### **I. Status of the Application**

Claims 21-39 are pending in this application. In the March 24, 2005 Office Action, the Examiner:

A. Rejected claims 21-22, 25, 27-30, 34-35 and 38-39 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent 4,314,304 to Baumbach in view of U.S. Patent 5,392,349 to Elder, Jr. and further in view of U.S. Patent 6,480,604 to Chandran;

B. Rejected claims 23-24, 31-32 and 36-37 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent 4,314,304 to Baumbach in view of U.S. Patents 5,392,349 and 6,480,604 to Elder, Jr. and Chandran, and further in view of U.S. Patent 4,677,518 to Hershfield; and

C. Objected to claims 26 and 33 as allowable but dependent upon rejected base claims.

#### **II. Claims 21-22, 25, 27-30, 34-35 and 38-39 Are Not Obvious Over Baumbach, Elder, Jr. and Chandran**

##### **A. The Claims**

##### **1. Claim 21**

In the March 24, 2005 Office Action, the Examiner rejected independent claim 21 as allegedly unpatentable over U.S. Patent 4,314,304 to Baumbach (hereinafter, Baumbach) in

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

view of U.S. Patent 5,392,349 to Elder, Jr. (hereinafter, Elder) and further in view of U.S. Patent 6,480,604 to Chandran (hereinafter Chandran). Applicants respectfully submit that independent claim 21 is not obvious over Baumbach, Elder and Chandran.

Particularly, the Examiner relies on Baumbach for allegedly "anticipating all limitations of the claim [21] with the exception of a first input resistance and a second input resistance in series with said first first-stage input and said second first-stage input...and said singular spark gap is provided across said first first-stage output and said second first-stage output" (see the 3-24-05 Office Action, page 3). As such, the Examiner relies on Baumbach as teaching a singular spark gap and dual secondary spark gaps connected in parallel with the singular spark gap. Applicants respectfully disagree.

The Examiner indicates that the gas tube surge arrestor 20 of Baumbach (see Fig. 1 of Baumbach) constitutes the singular spark gap of claim 21 (see Fig. 4, spark gap 26 of the present application) since the gas tube surge arrestor (20) is a "specialized spark gap where electrons are emitted in a gaseous medium enclosed within a tube" (see the 3-24-05 Office Action, page 3). Applicants respectfully disagree that the gas tube surge arrestor constitutes a *singular* spark gap as presently claimed.

In columns 2-3 lines 62-19 of Baumbach, Baumbach indicates that the gas tube surge arrestor 20 is of the three electrode type with first and second electrodes 22, 24 and a center electrode 26. The electrodes 22, 24 are connected to lines 11, 12. Thus, "there is an arc gap between each line electrode 22, 24 and the ground electrode 26" (col. 3, lines 3-5). Therefore, the gas tube surge arrestor 20 constitutes *two* spark gaps not a *singular* spark gap as alleged.

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

It has been shown above that Baumbach does not "anticipate all limitations of the claim [21] with the exception of a first input resistance and a second input resistance in series with said first first-stage input and said second first-stage input...and said singular spark gap is provided across said first first-stage output and said second first-stage output" as indicated by the Examiner since Baumbach lacks the limitation of a singular spark gap as presently claimed. Thus, the base reference (Baumbach) for the §103 rejection of claim 21 fails to teach what it was alleged to teach. Elder, Jr. and Chandran were not cited, nor do they teach, a singular spark gap as presently claimed. Therefore, the combination of Baumbach, Elder and Chandran cannot render claim 21 obvious under §103 since the combination of Baumbach, Elder, Jr. and Chandran does not teach each and every limitation of claim 21.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claim 21 and reconsideration thereof.

## 2. Claims 22 and 25

Each of claims 22 and 25 includes independent claim 21 as a base claim. The reasoning set forth above with regard to the patentability of independent claim 21 is thus applicable to the patentability of claims 22 and 25, and is therefore incorporated herein by reference. As a result, each of claims 22 and 25 are allowable over combination of Baumbach, Elder, Jr. and Chandran for at least the reasons hereinbefore discussed with regard to independent claim 21.

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claims 22 and 25 and reconsideration thereof.

### 3. Claim 27

In the March 24, 2005 Office Action, the Examiner rejected independent claim 27 as allegedly being unpatentable over the combination of Baumbach, Elder, Jr. and Chandran. Particularly, the Examiner rejected claim 27 for the same reasons as claim 21 since claim 27 is "essentially the same subject matter" as claim 21. Applicants respectfully submit that independent claim 27 is not unpatentable over the combination of Baumbach, Elder, Jr. and Chandran for the same reasons that claim 21 is not unpatentable over the combination of Baumbach, Elder, Jr. and Chandran. As such, the arguments with respect to the patentability of independent claim 21 are incorporated herein by reference with respect to the patentability of independent claim 27.

Therefore, in view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claim 27 and reconsideration thereof.

### 4. Claims 28-30

Each of claims 28-30 includes independent claim 27 as a base claim. The reasoning set forth above with regard to the patentability of independent claim 27 is thus applicable to the patentability of claims 28-30, and is therefore incorporated herein by reference. As a

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

result, each of claims 28-30 are allowable over combination of Baumbach, Elder, Jr. and Chandran for at least the reasons hereinbefore discussed with regard to independent claim 27.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claims 28-30 and reconsideration thereof.

#### 5. Claim 34

In the March 24, 2005 Office Action, the Examiner rejected independent claim 34 as allegedly being unpatentable over the combination of Baumbach, Elder, Jr. and Chandran. Particularly, the Examiner rejected claim 34 for the same reasons as claim 21 since claim 34 is "essentially the same subject matter" as claim 21. Applicants respectfully submit that independent claim 34 is not unpatentable over the combination of Baumbach, Elder, Jr. and Chandran for the same reasons that claim 21 is not unpatentable over the combination of Baumbach, Elder, Jr. and Chandran. As such, the arguments with respect to the patentability of independent claim 21 are incorporated herein by reference with respect to the patentability of independent claim 34.

Therefore, in view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claim 34 and reconsideration thereof.

#### 6. Claims 35 and 38-39

Each of claims 35 and 38-39 includes independent claim 34 as a base claim. The reasoning set forth above with regard to the patentability of independent claim 34 is thus

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

applicable to the patentability of claims 35 and 38-39, and is therefore incorporated herein by reference. As a result, each of claims 35 and 38-39 are allowable over combination of Baumbach, Elder, Jr. and Chandran for at least the reasons hereinbefore discussed with regard to independent claim 34.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claims 35 and 38-39 and reconsideration thereof.

III. Claims 23-24, 31-32 and 36-37 Are Not Obvious Over Baumbach, Elder, Jr., Chandran and Hershfield

A. The Claims

1. Claim 23 and 24

In the March 24, 2005 Office Action, the Examiner rejected claims 23-24 as allegedly being obvious over Baumbach, Elder Jr., Chandran and Hershfield. Applicants respectfully submit that claims 23 and 24 are not obvious over Baumbach, Elder Jr., Chandran and Hershfield since 1) Baumbach does not teach each and every limitation of the base claim of claim 23 (i.e. independent claim 21) as shown above, and 2) Hershfield does teach the limitations lacking in Baumbach, Elder Jr., and Chandran.

As pointed out by the above arguments regarding the patentability of independent claim 21, of which arguments are specifically incorporated herein by reference, the main

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

reference Baumbach does not teach the limitations of the base claim 21 as alleged by the Examiner. Recapping the above arguments, Baumbach does not teach a *singular* spark gap. Hershfield does not teach or suggest (and thus is not cited by the Examiner for so teaching or suggesting) a singular spark gap as recited in independent claim 21. Therefore, the combination of Baumbach, Elder Jr., Chandran and Hershfield can not overcome the shortcomings of Baumbach regardless of any additional teaching supplied by Hershfield. Moreover, claims 23 and 24, which depend from and thus incorporate the limitations of independent claim 21, are not obvious over Baumbach, Elder Jr., Chandran and Hershfield. As a result, claims 23 and 24 are allowable over Baumbach, Elder Jr., Chandran and Hershfield.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claims 23 and 24, and reconsideration thereof.

## 2. Claims 31 and 32

In the March 24, 2005 Office Action, the Examiner rejected claims 31 and 32 as allegedly being obvious over Baumbach, Elder Jr., Chandran and Hershfield. Applicants respectfully submit that claims 31 and 32 are not obvious over Baumbach, Elder Jr., Chandran and Hershfield since 1) Baumbach does not teach each and every limitation of the base claim of claims 31 and 32 (i.e. independent claim 27), and 2) Hershfield does not teach the limitations lacking in Baumbach, Elder Jr., Chandran.

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

As pointed out by the above arguments regarding the patentability of independent claim 27, of which arguments are specifically incorporated herein by reference, the main reference Baumbach does not teach the limitations of the base claim 27 as alleged by the Examiner. Recapping the above arguments, Baumbach does not teach a *singular* spark gap. Hershfield does not teach or suggest (and thus is not cited by the Examiner for so teaching or suggesting) a singular spark gap as recited in independent claim 27. Therefore, the combination of Baumbach, Elder Jr., Chandran and Hershfield can not overcome the shortcomings of Baumbach regardless of any additional teaching supplied by Hershfield. Moreover, claims 31 and 32, which depend from and thus incorporate the limitations of independent claim 27, are not obvious over Baumbach, Elder Jr., Chandran and Hershfield. As a result, claims 31 and 32 are allowable over Baumbach, Elder Jr., Chandran and Hershfield.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claims 31 and 32, and reconsideration thereof.

### 3. Claims 36 and 37

In the March 24, 2005 Office Action, the Examiner rejected claims 36 and 37 as allegedly being obvious over Baumbach, Elder Jr., Chandran and Hershfield. Applicants respectfully submit that claims 36 and 37 are not obvious over Baumbach, Elder Jr., Chandran and Hershfield since 1) Baumbach does not teach each and every limitation of the base claim



Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

of claims 36 and 37 (i.e. independent claim 34), and 2) Hershfield does not teach the limitations lacking in Baumbach, Elder Jr., Chandran.

As pointed out by the above arguments regarding the patentability of independent claim 34, of which arguments are specifically incorporated herein by reference, the main reference Baumbach does not teach the limitations of the base claim 34 as alleged by the Examiner. Recapping the above arguments, Baumbach does not teach a *singular* spark gap. Hershfield does not teach or suggest (and thus is not cited by the Examiner for so teaching or suggesting) a singular spark gap as recited in independent claim 34. Therefore, the combination of Baumbach, Elder Jr., Chandran and Hershfield can not overcome the shortcomings of Baumbach regardless of any additional teaching supplied by Hershfield. Moreover, claims 36 and 37, which depend from and thus incorporate the limitations of independent claim 34, are not obvious over Baumbach, Elder Jr., Chandran and Hershfield. As a result, claims 36 and 37 are allowable over Baumbach, Elder Jr., Chandran and Hershfield.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claims 36 and 37, and reconsideration thereof.

#### IV. Allowable Subject Matter (Claims 26 and 33).

In the March 24, 2005 Office Action, the Examiner indicated that claims 26 and 33 were objected to as being dependent upon a rejected base claim but would be allowable if

Application No. 10/085,499  
Response to Office Action of March 24, 2005

PU010044

rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Applicants acknowledge the allowability of claims 26 and 33. However, since Applicants have shown above that independent base claims 21 and 27 are patentable over Baumbach, Elder Jr., Chandran and Hershfield, Applicants respectfully decline at this time to rewrite claims 26 and 33 in independent form.

V. Conclusion

It is respectfully submitted that all claims are in condition for allowance. Accordingly, Applicants respectfully request withdrawal of all rejections and objections, reconsideration of all claims, and that a timely Notice of Allowance of all claims be issued in this case.

Respectfully Submitted,

5-26-05  
May 26, 2005

  
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